

REMARKS

Entry of this Amendment and reconsideration are respectfully requested in view of the amendments made to the claims and for the remarks made herein.

Claims 1-25 are pending and stand rejected

Claim 1, 19, 21, 22, 23 and 25 has been amended.

Claim 20 has been cancelled without prejudice.

Claims 1 and 19 are independent claim.

Claims 1-3, 5, 19 and 24-25 stand rejected under 35 USC 102(b) as being anticipated by USP no. 5,051,340. Claim 4 stands rejected under 35 USC 103(a) as being obvious over USP no. 5,051,340. Claims 6, 9-12, 14-15 and 21-23 stand rejected under 35 USC 103(a) as being unpatentable over USP no. 5,051,340 in view of USP no. 6,030,556. Claim 20 stands rejected under 35 USC 103(a) as being unpatentable over USP no. 5,051,340 in view of USP no. 5,759,749. Claims 7-8 stand rejected under 35 USC 103(a) as being unpatentable over USP no. 5,051,340 in view of USP no. 4,732,844. Claim 13 stands rejected under 35 USC 103(a) as being unpatentable over USP no. 5,051,340 in view of JP 06-060440. Claims 16-17 stand rejected under 35 USC 103(a) as being unpatentable over USP no. 5,051,340 in view of USP no. 6,709,801. Claims 1-25 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-21 of copending Application no. 10/599,834.

With regard to the rejection of the claims under 35 USC 102, applicant respectfully disagrees with and explicitly traverses the rejection of the claims. However, in the interest of advancing the prosecution of this application, applicant has elected to amend the independent claims to more clearly state the invention claimed. More specifically, the independent claims have been amended to further recite the etching at least of the interface layer using a different process than used in etching the mask layer. No new matter have been

added. Support for the amendment may be found at least in Figures 14A-14C, on page 12, lines 25-29 and, in part, in claim 20. Although claim 20, which depends from claim 19, has been rejected as being unpatentable over Tyan and Ota, it will be shown that the combination of Tyan and Ota fails to disclose the subject matter recited in claim 20 and now in the amended independent claims.

Tyan (USP no. 5,051,340) discloses a method for manufacturing a master of the replication of optical elements by focusing an information modulated energy beam on a phase change optical recording layer so as to form a pattern of two different phases in the layer and selectively etching away one of the two different phases so as to form a relief pattern.

Tyan fails to disclose using a different process to further etch an interface material using a different process than used in etching the recording layer.

A claim is anticipated if and only if each and every element recited in the claims is disclosed in a single prior art reference.

Tyan cannot be said to anticipate the subject matter recited in the independent claims as Tyan fails to disclose the etching of a second layer.

Applicant submits that for the amendments made to the claims, the rejection of the claims has been overcome.

With regard to the rejection of claim 20 as being unpatentable over Tyan in view of Ota (USP no. 4,732,844), applicant respectfully disagrees with and explicitly traverses the rejection of the claims.

Ota (USP no. 4,732,844) discloses a method for manufacturing an optic disk having both address pits and grooves having accurately controlled depths and widths using two different types of sensitive materials of different characteristics applied to a recording original board. Ota discloses using multiple etchings to create different regions –the address and the guiding grooves – in the recording material. However, Ota fails to disclose that the multiple etching is performed using different processes, as is recited in the claims. Rather Ota

discloses using a first wavelength to etch a first layer and a second wavelength to etch a second layer.

Accordingly, the independent claims include subject matter not disclosed by the combination of Tyan and Ota.

A claimed invention is *prima facie* obvious when three basic criteria are met. First, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings therein. Second, there must be a reasonable expectation of success. And, third, the prior art reference or combined references must teach or suggest all the claim limitations. The Court in *KSR v. Teleflex* (citation omitted) has held that the teaching, suggestion and motivation test (TSM) is merely to be used as a helpful hint in determining obviousness and a bright light application of such a test is adverse to those factors for determining obviousness enumerated in *Graham v. John Deere* (i.e., the scope and content of the prior art, the level of ordinary skill in the art, the differences between the claimed invention and the prior art and objective indicia of non-obviousness) (citation omitted).

In this case, the combination of the cited references fails to disclose a material element recited in claim 20, which is now incorporated into independent claims 1 and 19, and thus, each of the independent claims is not rendered obvious by the cited references.

With regard to the remaining claims, each of these claims expresses further aspects of the invention claimed and depends from the subject matter recited in claims 1 and 19. None of the other cited references provides any teaching regarding multiple etching using different processes as is recited in the independent claims. Consequently, each of the remaining claims is also in an allowable form by virtue of their dependency upon an allowable base claim.

With regard to the provisional rejection of claims 1-25 on the ground of nonstatutory obviousness-type double patenting over claims 1-21 of co-pending Application no. 10/599,834, applicant respectfully requests that the rejection be held in abeyance until such time that either the instant application or the referred to application issues and the issued claims may then be compared to those of the remaining application to determine whether the rejection is still applicable.

For the amendments made to the claims and for the arguments presented herein, applicant submits that the rejections of the claims has been overcome and respectfully requests that the rejections be withdrawn. The issuance of Notice of Allowance in this matter is respectfully requested.

Applicant denies any statement, position or averment stated in the Office Action that is not specifically addressed by the foregoing. Any rejection and/or points of argument not addressed are moot in view of the presented arguments and no arguments are waived and none of the statements and/or assertions made in the Office Action is conceded.

Applicant makes no statement regarding the patentability of the subject matter recited in the claims prior to this Amendment and has amended the claims solely to facilitate expeditious prosecution of this patent application. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by the originally filed claims, as presented prior to this Amendment, and any additional claims in one or more continuing applications during the pendency of the instant application.

In the event the Examiner deems personal contact desirable in the disposition of this case, the Examiner is invited to call the undersigned attorney at the telephone given below.

Respectfully submitted,
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